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6-8-03 AF 3711
16/REPLY
BRIEF
P/1629-43

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

John SKALEN

Date: May 29, 2003

Serial No.: 09/787,750

Group Art Unit: 3711

Filed: May 21, 2001

Examiner: M. Chambers

For: GOLF TRAINING DEVICE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**BEFORE THE BOARD OF PATENT
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REPLY BRIEF PURSUANT TO 37 C.F.R. §1.193(b)(1)

Sir:

This Reply Brief is in response to the Examiner's Answer dated April 1, 2003.

As demonstrated beginning at the second paragraph on page 4 of his Answer, it is clear that the Examiner has failed to address the real issue and appellant's position on this appeal. Appellant is not asserting "that the novelty with the method use for the instant invention should permit the apparatus to issue", as stated by the Examiner, but rather, that the claimed *functional relationship* between the indicator marks and the structural elements is both novel and unobvious, and that under the controlling authority, such a claimed functional relationship must be taken into account in determining patentability.

Inexplicably, the Examiner's Answer does not mention the controlling cases such as *In re Miller*, 57 CCPA 89, 418 F.2d 1932, 164 U.S.P.Q. 46, 49 (CCPA 1969), and *In re Gulack*, 703 F.2d 1381, 217 U.S.P.Q. 401 (CAFC 1983). Indeed, one wonders if the Examiner even considered these

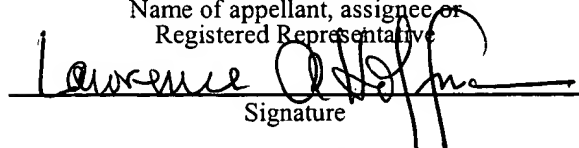
cases. Had he done so, he could not have helped but appreciate the issue here, and also would not have stated as he did at the top of page 6 of his Answer that "there is and was no "printed matter" rejection made". Precisely the same issue is involved here as in both *Miller* and *Gulack, supra*, i.e., the patentability of claimed combinations of structure and markings on the structure. Indeed, the claim on appeal in *Miller* used the word "indicia" to describe the markings on a structural element (a receptacle).

Despite the Examiner's unaccountable silence on the subject, the fact remains that under *Gulack, supra*:

... the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole (citations omitted) ... The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate" *In re Gulack*, 217 U.S.P.Q. at 303, 404.

Thus, in determining patentability, the Examiner should have considered if there is a novel and unobvious functional relationship between appellant's claimed indicia A-C and lines 2 and 7 as compared to the functional relationship between tape 11 and bead 11a in Deane. As demonstrated in appellant's main brief, the claims on appeal do define a novel and unobvious functional relationship between the markers and the lines, i.e., to permit proper setup of the device for use with different clubs. This functional relationship is neither taught nor suggested in the Deane patent, or in the Widnall patent, either alone or in combination, and accordingly, the final rejection of claims 6-11 should be reversed and this application passed to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on May 29, 2003:

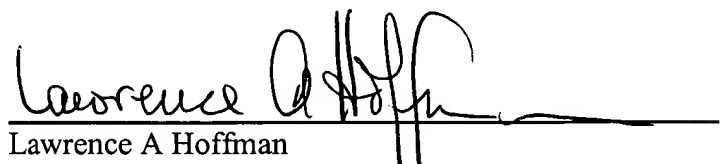
Lawrence A Hoffman
Name of appellant, assignee, or
Registered Representative


Signature

May 29, 2003
Date of Signature

LAH:sks

Respectfully submitted,



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